

GP-302441

REMARKS

Claims 1-14 remain pending in the present Application. Applicants appreciate the indication that Claims 6-14 stand allowed. The Drawings have been amended to add Figures 5 and 6. Paragraph [0020] has been amended to include a reference to the added Figures. Support can be found variously in the specification and in original Claims 5 and 6.

Reconsideration and allowance of the remaining claims is respectfully requested in view of the following remarks.

Drawing Objection

Applicants submit herewith corrected drawing sheets.

Claim Objection

Claim 6 is objected to under 237 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants respectfully traverse.

Applicants are unclear as to the reasons for the objection. Claim 6 depends from Claim 1. Claim 1 is directed to a magnetorheological damper, the damper comprising, *inter alia*, a piston assembly comprising a plurality of cylindrically shaped fluid passageways extending from the first chamber to the second chamber, and at least one electromagnet. Claim 6 further limits the cylindrically shaped fluid passageways, wherein the cylindrically shaped fluid passageway has a diameter that decreases from the first chamber to the second chamber. Dependent Claim 5 did not have this rejection and is directed to wherein the cylindrically shaped fluid passageway has a diameter that increases from the first chamber to the second chamber. It is not clear how the term "increases" as in Claim 5 is considered as further limiting whereas the term "decreasing" as in Claim 6 does not.

Moreover, it is clear that Claim 6 is further narrowing the cylindrically shaped passageways by defining the cylindrically shaped passageways as having a diameter that decreases from a first chamber to a second chamber.

GP-302441

If the reason for the objection is related to the drawing objection, Applicants have filed concurrently herewith corrected drawings showing that "the cylindrically shaped fluid passageways have a diameter that decreases from the first chamber to the second chamber."

For at least these reasons, it is respectfully requested that the objection be withdrawn.

Claim Rejection Under 35 U.S.C. §102(b)

Claims 1, 5, 6, and 7 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by US Patent No. 4,673,067 to Munning et al. (hereinafter "Munning"). Applicants respectfully traverse.

Claim 1 is directed to a magnetorheological damper comprising a cylindrically shaped housing; a magnetorheological fluid disposed in the cylindrically shaped housing; a piston assembly disposed within the cylindrically shaped housing in sliding engagement with the cylindrically shaped housing defining a first chamber and a second chamber, wherein the piston assembly comprises a plurality of cylindrically shaped fluid passageways extending from the first chamber to the second chamber, and at least one electromagnet; and a power supply in electrical communication with the at least one electromagnet.

Munning is generally directed to an electromagnetically adjustable shock absorber comprising an electromagnetic drive in operative communication with a throttling member. The throttle member electromagnetically controls the dimensions of the cross sectional passages of the piston and thus, the hydraulic pressure of fluid flowing through the passageways to provide damping.

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

Munning fails to anticipate Claims 1, 5, 6, and 7 because Munning fails to disclose a magnetorheological fluid disposed in a cylindrically shaped housing. In Munning, the throttle member is electromagnetically controlled to effect changes in the dimensions of the cross

GP-302441

sectional passages to provide damping. There is no disclosure of a magnetorheological fluid as claimed by Applicants.

Accordingly, the rejection of Claims 1, 5, 6, and 7 is requested to be withdrawn for at least this reason.

Claim Rejection Under 35 U.S.C. § 103(a)

Claim 2 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Munning. Applicants respectfully traverse.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicants traverse the rejection on the grounds that Munning fails to establish a *prima facie* case of obviousness against independent Claim 2. A *prima facie* case against Claim 1 has not been established because the cited reference fails to teach or suggest a magnetorheological damper comprising a magnetorheological fluid.

Accordingly, the rejection is requested to be withdrawn for at least this reason.

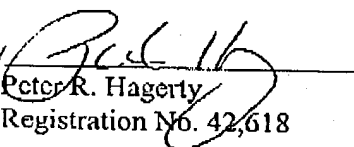
It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

GP-302441

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorneys.

Respectfully submitted,

CANTOR COLBURN LLP

By 
Peter R. Hagerly
Registration No. 42,618

Date: June 28, 2004
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No.: 23413